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EXAMINER

NGUYEN, TANH Q

ART UNIT

PAPER NUMBER

2182

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/884,318	ANDERSON ET AL. 
	Examiner Tanh Q. Nguyen	Art Unit 2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 June 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
 - 4a) Of the above claim(s) 7-11 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5 and 12-17 is/are rejected.
- 7) Claim(s) 6 and 18 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 18 June 2001 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2, 3, 4</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-6, 12-18 drawn to document relaying, classified in class 710, subclass 20 (concurrent I/O and data transfer).
 - II. Claims 7-11, drawn to document rendering, classified in class 710, subclass 65 (I/O data modification).
2. The inventions are distinct, each from the other because of the following reasons:
Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination includes "document relaying from a portable device to a local printer, then to a host". The subcombination has separate utility such as "determining a file type of the non-rendered document" and "launching an application in the host with a set of instructions to print document on the local printer".
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and the

Art Unit: 2182

search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with the attorney for applicant, James R. Mc Daniel (Reg. No. 34,481) on 06/08/2004, a provisional election was made with traverse to prosecute the invention of I, claims 1-6, 12-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 2182

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1, 3-5, 13, 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Dei et al. (USP 6,496,276)**.

11. As per claim 1, Dei teaches a printing method, comprising:
 relaying a non-rendered document (print data from still camera 12: col. 3, line 61) from a local printer [1, FIG. 2] to a host [9, FIG. 2] coupled thereto, the non-rendered document being received in the local printer from a portable device [12, FIG. 2; col. 4, lines 50-55] via a portable device communications port [6, FIG. 2];
 rendering the non-rendered document into a format compatible with the local printer (print data coming from the host being printed by the printer: col. 1, lines 47-54: hence print data coming from the host being compatible with the printer), thereby creating a rendered document (processed print data: col. 4, lines 5-6); and

sending the rendered document to the local printer for printing (col. 4, lines 6-12).

Dei does not explicitly teach identifying one of a number of applications in the host that is compatible with the non-rendered document, and using the identified application to render the non-rendered document.

It was, however, well known in the art at the time the invention was made for a user of a host to process print data (to render a non-rendered document) using one of a number of local printer compatible applications. It would have been, therefore, obvious to one of ordinary skill in the art at the time the invention was made for the user to identify one of the local printer compatible applications to process print data for the purpose of printing the print data in a format most appealing to the user.

12. As per claims 3-5, Dei teaches the print data from the portable device being sent to the host through the local printer (col. 3, line 61-col. 4, line 1), hence the non-rendered document received from the local printer being sent to the host, and therefore stored in a memory of the host - claim 3;

infrared communication between the local printer and the portable device [6, 11, 16, 17, FIG. 2], hence a wireless communication with the portable device, wherein the portable device communications port is a wireless communications port [11, FIG. 2] - claim 4;

the processed print data being supplied to the printing unit (col. 4, lines 6-10), hence launching the identified application in the host with instructions to print the document using the local printer - claim 5.

Art Unit: 2182

13. As per claim 13, Dei teaches a printing system, comprising:
 - a host [9, FIG. 2] and a local printer [1, FIG. 2] coupled thereto, the local printer having a portable device communications port [6, FIG. 2] with which to establish a communications link with a portable device [12, FIG. 2];
 - means in the local printer [6, b, 5, 18, 4, a, FIG. 2] or relaying a non-rendered document received via the portable device communications port to the host for rendering; and
 - means in the host for orchestrating a rendering of the non-rendered document into a rendered document with a printer format compatible with the local printer (col. 4, lines 5-6); and
 - means in the host for transmitting a rendered document to the local printer to be printed (col. 4, lines 6-12).

Dei does not explicitly teach the non-rendered document being rendered using one of a number of applications in the host.

It was, however, well known in the art at the time the invention was made for a user of a host to process print data (to render a non-rendered document) using one of a number of local printer compatible applications in the host. It would have been, therefore, obvious to one of ordinary skill in the art at the time the invention was made for the user to process the non-rendered document with one of the local printer compatible applications for the purpose of printing the print data in a format most appealing to the user.

14. As per claims 15-17, see the rejections to claims 13 and 3-5 above.

15. Claims 1-5, 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Jia (Application S/N 09/799,381)**.

16. As per claim 1, Jia teaches a printing method, comprising:

relaying a non-rendered document from a local printer [106, FIG. 1; page 5, lines 19-20] to a host [109, FIG. 1] coupled thereto (page 8, lines 7-22), the non-rendered document being received in the local printer from a server [103, FIG. 1] via a server communications port through a network [113, FIG. 1];

identifying one of a number of applications in the host that is compatible with the non-rendered document (page 8, lines 22-30);

rendering the non-rendered document with the one of the number of applications into a format compatible with the local printer, thereby creating a rendered document (page 8, lines 30-32); and

sending the rendered document to the local printer for printing (page 9, lines 1-9).

Jia, therefore, teaches the claimed invention except for the non-rendered document being explicitly received in the local printer from a portable device via a portable device communications port.

Jia, however, teaches the network [113, FIG. 1] including a suitable network (page 7, lines 1-2) and the server [103, FIG. 1] being representative of a multitude of servers that contains pages 139 that may be accessed and viewed/manipulated with the client 106 (page 5, lines 17-18).

It would have been, therefore, obvious to one of ordinary skill in the art at the

Art Unit: 2182

time the invention was made to practice Jia's invention with the server [103, FIG. 1] being a portable device - such as a PDA or a portable computer, and with such portable device communicating with the local printer via a communications port on the local printer adapted for communications with such portable device, to allow the local printer to receive document from a portable device.

17. As per claims 2-5, Jia teaches determining a file type of the non-rendered document (page 10, lines 1-2, 8-10); and identifying the one of the number of applications in the host that is compatible with the non-rendered document further comprising searching through the number of applications in the host to identify the one of the number of applications that is compatible with the file type (page 12, lines 21-31; page 13, lines 11-15; page 8, lines 22-32) - claim 2;

the non-rendered document being sent to the host from the local printer (page 8, lines 19-22), hence the non-rendered document being stored in a memory of the host - claim 3;

since it was known in the art at the time the invention was made for a PDA or a portable computer to wirelessly communicate with a local printer, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the portable device communications port on the local printer to be a wireless communications port to allow for wireless communications between a PDA or a portable computer with the local printer - claim 4.

the processing agent [176, FIG. 1] being embodied in a medium for use by or in connection with an instruction execution system (page 17, lines 8-10), hence launching

Art Unit: 2182

the identified application in the host with instructions to print the document using the local printer - claim 5.

18. As per claim 12, Jia teaches a document relay system in a printer [106, FIG. 1], comprising:

a processor circuit with a processor [143, FIG. 1] and a memory [146, FIG. 1];
a device communications port [connection between 106 and 113, FIG. 1] coupled to the processor circuit to establish a data communication between the printer and a remote device [103, FIG. 1]; and
a document relay service stored in the memory [159, FIG. 1] and executable by the processor, the document relay service comprising:

logic that determines whether a document received from the remote device via the portable device communications port is rendered in a format compatible with the printer (page 8, lines 15-19); and

logic that relays the document to a host to be rendered for the printer if the document is not compatible with the printer (page 8, lines 19-22).

Jia, therefore, teaches the claimed invention except for the remote device being explicitly a portable device.

Jia, however, teaches the network [113, FIG. 1] including a suitable network (page 7, lines 1-2) and the server [103, FIG. 1] being representative of a multitude of servers that contains pages 139 that may be accessed and viewed/manipulated with the client 106 (page 5, lines 17-18).

It would have been, therefore, obvious to one of ordinary skill in the art at the

time the invention was made to practice Jia's invention with the server [103, FIG. 1] being a portable device - such as a PDA or a portable computer, and with such portable device communicating with the local printer via a communications port on the local printer adapted for communications with such portable device, to allow the local printer to receive document from a portable device.

19. As per claim 13, Jia teaches a printing system [FIG. 1], comprising:

a host [109, FIG. 1] and a local printer [106, FIG. 1] coupled thereto, the local printer having a device communications port [106-113 connection, FIG. 1] with which to establish a communications link with a remote device [103, FIG. 1];

means in the local printer [159, FIG. 1] for relaying a non-rendered document received via the remote device communications port to the host for rendering (page 8, lines 15-22); and

means in the host for orchestrating a rendering of the non-rendered document into a rendered document with a printer format compatible with the local printer, the non-rendered document being rendered using one of a number of applications in the host (page 8, lines 22-32); and

means in the host for transmitting a rendered document to the local printer to be printed (page 9, lines 1-9).

Jia, therefore, teaches the claimed invention except for the remote device being explicitly a portable device.

Jia, however, teaches the network [113, FIG. 1] including a suitable network (page 7, lines 1-2) and the server [103, FIG. 1] being representative of a multitude of

servers that contains pages 139 that may be accessed and viewed/manipulated with the client 106 (page 5, lines 17-18).

It would have been, therefore, obvious to one of ordinary skill in the art at the time the invention was made to practice Jia's invention with the server [103, FIG. 1] being a portable device - such as a PDA or a portable computer, and with such portable device communicating with the local printer via a communications port on the local printer adapted for communications with such portable device, to allow the local printer to receive document from a portable device.

20. As per claims 15-17, see the rejections to claims 13 and 2-5 above.

Allowable Subject Matter

21. Claims 6 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tanh Quang Nguyen whose telephone number is (703) 305-0138, and whose e-mail address is tanh.nguyen36@uspto.gov. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin, can be reached on (703) 308-3301. The fax phone number

Art Unit: 2182

for the organization where this application or proceeding is assigned is 703-872-9306
for After Final, Official, and Customer Services, or (703) 746-5672 for Draft to the
Examiner (please label "PROPOSED" or "DRAFT").

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